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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,369	06/14/2000	ERIC BARLOW	61512/CCD/RS	9882

7590 10/23/2002  
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EXAMINER

MCNEIL, JENNIFER C

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/23/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/508,369

Applicant(s)

BARLOW ET AL.

Examiner

Jennifer McNeil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of Group I is acknowledged. The traversal is on the ground(s) that the prior art discloses silane which are supposedly precluded by the claims, and that there is no teaching or suggestion to apply a chromate treatment with an anodic film. This is not found persuasive because the claims are no longer commensurate with this argument with regard to silanes. An anodic oxide film is not structurally limited to being formed anodically. An oxide film may be formed by a number of methods including simple exposure to oxygen. It is not shown that the term "anodically" limits the structure of the coating formed. Also, the method claims require a precleaning of the surface of the workpiece, that is not required by the article claims. This precleaning treatment is also considered a special technical feature that is not shared by the claims.

The requirement is still deemed proper and is therefore made FINAL.

Rejoinder will be considered upon indication of the allowability of the article claims, and if the article and method claims share all limitations.

***Specification***

The abstract of the disclosure is objected to because of numerous grammatical errors. For instance: page 4, lines 23, should read -a painted sheet--; page 4, line 31 should read -painted sheets—or -a painted sheet--; page 5, line 5 should read -Primed aluminum sheets--. These are only examples of the numerous errors in the specification and applicant is encouraged to review the specification and correct all such errors. Correction is required. See MPEP § 608.01(b).

*Claim Objections*

Claims 3, 6, 9, and 13 are objected to because of the following informalities: Each claim contains grammatical errors. In claim 3, line 1, should --an-- be inserted after "is"? Claim 6, line 1, should --a-- be inserted after "is"? Claim 9, line 1, should --an-- be inserted after "is"? Claim 13, line 2, should --a-- be inserted after "is". Applicant is encouraged to check the claims for any other errors. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's claims have been amended since the filing of the original PCT. The amendment constitutes changing "silanes" to "silicon-organic compounds". While silanes are silicon-organic compounds, not all silicon-organic compounds are silanes. There does not appear to be any support in the specification for the negative limitation of the exclusion of silicon-organic compounds in the coating.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the exclusion of silanes, does not reasonably provide enablement for exclusion of silicon-organic compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. As stated above, the specification does not appear to enable the claims, in that the specification provides for the exclusion of silanes from the coating, but does not provide support for the exclusion of silicon-organic compounds.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 includes alternative language, but it is not clear what choices are to be included. Are the pretreatments part of the alternative grouping? It also appear to be redundant to have the phrase "at least one" used twice for the same grouping, as in lines 3-4.

Claims 2 and 3 use improper alternative language.

Claim 9 uses improper alternative language. Is the adhesive an addition to or an alternative to the paint layer?

Claim 12 seems to be unfinished. Inorganic what? Are these compounds that are inorganic as opposed to organic?

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8, 9, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuo et al (EP 426328A2). Matsuo et al teach coating a work article surface with an anodic coating (chromate conversion coating) followed by a resin coating. The work article may comprise an aluminum plate (page 12, line 4), and the resin coating may comprise additives such as MoS<sub>2</sub> and SiO<sub>2</sub> (page 5). A subsequent cationic electrodeposition of paint is deposited on the resin coating (page 2, lines 23-26; page 3, lines 17-21; page 4, lines 37-42; page 4, line 47- page 5, line 15).

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Claims 1, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Totsuka et al (US 5,395,687). Totsuka et al teach a surface-treated aluminum material. The aluminum material is first coated with a chromate film, followed with an organic resin. The organic resin may include a fluororesin (col. 8, lines 45-52). Totsuka teaches that the aluminum material may be used in automobiles (col. 7, lines 24-26).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugama (US 4,889,718). Sugama teaches an oxidized aluminum substrate with a primer between the substrate and a polyurethane top coating. The primer coating may be polyacrylic acid. The polyacid is an adhesion promoter and the polyurethane is considered a lacquer coating (col. 1, lines 10-34; col. 3, line 45 -col. 4, line 4; Example 1; col. 6, lines 1-37).

Claims 1, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Borresen et al (US 4,138,526). Borresen et al teach a metal substrate with a primer coating thereon. The primer coating serves to promote adhesion and may include sodium metasilicate (col. 3, lines 5-10).

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al (EP 426328A2). Matsuo et al teach coating a work article surface with an anodic coating (chromate conversion coating) followed by a resin coating, as discussed above. Matsuo do not give specific thicknesses of the anodic oxide film or a weight of the adhesion promoter coating. Absent a showing of unexpected results, optimization of both of these values is considered within the purview of one of ordinary skill in the art, since it has been held that where the general conditions of a claim are disclosed

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in the prior art, discovering the optimum or workable ranges involves only routine skill in the art ( *In re Aller*, 105 USPQ 233).

Regarding claim 6, this limitation is considered to be intended use, and does not provide structural or functional definition over the article of the prior art.

*Response to Arguments*

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. Regarding the term "anodic oxide film", this is not considered limiting to a film form by an anodic deposition. The final product is an oxide film and is considered to read on any oxide film, absent a structural difference.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer McNeil whose telephone number is 703-305-0553. The examiner can normally be reached on Monday through Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jennifer McNeil  
Examiner  
Art Unit 1775

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER

  
JCM

October 17, 2002